

PATENT
Application No. 09/676,380

Group I. Claims 1-5, drawn to polynucleotides.

Group II. Claims 6-8, drawn to fusion proteins.

Group III. Claims 9-23 drawn to assays.

Responsive to the Requirement for Restriction, Applicants elect to prosecute the invention of Group III, with traverse, Claims 9 -23, which are drawn to assays.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 “two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions.” Inventions are “independent” if “there is no disclosed relationship between the two or more subjects disclosed” (MPEP 802.01). The term “distinct” means that “two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER” (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, “[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the

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merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and Search. Claims 1-5 of Group I are drawn to polynucleotides and claims 9 –23 of Group III are drawn to assays, both of which are classified in class 435 and thus would require an additional search of the identical class, thus resulting in a duplicate search for the same material. Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Group I with Group III can be made without serious burden, and therefore the Examiner must examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I and Group III is in order.

No fees are believed to be necessitated by the foregoing Response other than the fee for the first month's extension for filing the foregoing Response. Should this be erroneous, authorization is hereby given to charge Deposit Account No. 501317 for any underpayment or credit any overages.

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In view of the above, withdrawal of the Requirement for the Restriction is requested, and
an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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Date: 2/4/02